

**REMARKS/ARGUMENTS**

I. Status of the Application

Claims 21-39 are pending in this application. In the August 26, 2004 Office Action, the Examiner:

A. Rejected claims 21-22, 24-30, 32-35 and 37-39 under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 5,416,663 to Atkins; and

B. Rejected claims 23, 31 and 36 under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent 5,416,663 to Atkins in view of U.S. Patent 4,677,518 to Hershfield.

II. Claims 21-22, 24-30, 32-35 and 37-39 Are Not Anticipated by Atkins

A. The Claims

1. Claim 21

In the August 26, 2004 Office Action, the Examiner rejected independent claim 21 as allegedly anticipated by Atkins. Applicants respectfully submit that independent claim 21, as amended, is not anticipated by Atkins since Atkins does not teach each and every limitation of claim 21.

For instance, Atkins does not teach a *singular* spark gap provided across a first first-stage output and a second first-stage output of a first stage of a telephony protection device as recited in amended independent claim 21. Rather, Atkins teaches a *dual* spark gap across a tip

and ring line in an arrangement for protecting telecommunications equipment from voltage transients.

That Atkins teaches a dual spark gap rather than a singular spark gap is confirmed in the August 26, 2004 Office Action. In the August 26, 2004 Office Action, the Examiner argued in support of a §102(b) rejection of claim 21, that Atkins discloses the use of “a *pair* of voltage shunting elements (3)” that “while depicted as clamping diodes” may be “spark gaps (column 2, lines 44-47)(i.e. a primary spark gap)” (see the August 26, 2004 Office Action, page 2). In so making this argument, the Examiner was reading the dual spark gap configuration and/or teaching of Atkins on a primary spark gap limitation as was then present in claim 21. A dual spark gap, however, is not a singular spark gap as recited in independent claim 21 nor can it be equated with one. For example, each shunting element (3) of Atkins’ dual spark gap is connected to line and ground, a configuration which is not achievable with a singular spark gap.

It is well settled law that to anticipate, each and every limitation of the claim must be taught in a single reference. Since it has been shown above that Atkins does not teach a singular spark gap provided across a first first-stage output and a second first-stage output of a first stage of a telephony protection device as recited in independent claim 21, independent claim 21, as amended, cannot be anticipated by Atkins. Withdrawal of the §102(b) rejection to claim 21 and reconsideration thereof is thus respectfully requested.

2. Claims 22 and 24-26

Each of claims 22 and 24-26 includes independent claim 21 as a base claim. The reasoning set forth above with regard to the patentability of independent claim 21 is thus applicable to the patentability of claims 22 and 24-26, and is therefore incorporated herein by reference. As a result, each of claims 22 and 24-26 are allowable over Atkins for at least the reasons hereinbefore discussed with regard to independent claim 21.

In view of the above, Applicants respectfully request the withdrawal of the §102(b) rejection of claims 22 and 24-26 and reconsideration thereof.

3. Claim 27

In the August 26, 2004 Office Action, the Examiner rejected independent claim 27 as allegedly anticipated by Atkins. Applicants respectfully submit that independent claim 27, as amended, is not anticipated by Atkins since Atkins does not teach each and every limitation of claim 27.

For instance, independent claim 27 includes the limitation of a singular spark gap such as was recited in independent claim 21. As such, the reasoning set forth above with regard to the patentability of independent claim 21 is applicable to independent claim 27 and is hereby incorporated herein by reference. As a result, independent claim 27 must be allowable over Atkins.

In view of the above, Applicants respectfully request the withdrawal of the §102(b) rejection of claim 27 and reconsideration thereof.

4. Claims 28-30 and 32-33

Each of claims 28-30 and 32-33 includes independent claim 27 as a base claim. The reasoning set forth above with regard to the patentability of independent claim 27 is thus applicable to the patentability of claims 28-30 and 32-33, and is therefore incorporated herein by reference. As a result, each of claims 28-30 and 32-33 must be allowable over Atkins.

In view of the above, Applicants respectfully request the withdrawal of the §102(b) rejection of claims 28-30 and 32-33 and reconsideration thereof.

5. Claim 34

In the August 26, 2004 Office Action, the Examiner rejected independent claim 34 as allegedly anticipated by Atkins. Applicants respectfully submit that independent claim 34, as amended, is not anticipated by Atkins since Atkins does not teach each and every limitation of claim 34.

For instance, independent claim 34 includes the limitation of a singular spark gap such as was recited in independent claim 21. As such, the reasoning set forth above with regard to the patentability of independent claim 21 is applicable to independent claim 34 and is hereby incorporated herein by reference. As a result, independent claim 34 must be allowable over Atkins.

In view of the above, Applicants respectfully request the withdrawal of the §102(b) rejection of claim 34 and reconsideration thereof.

6. Claims 35 and 37-39

Each of claims 35 and 37-39 includes independent claim 34 as a base claim. The reasoning set forth above with regard to the patentability of independent claim 34 is thus applicable to the patentability of claims 35 and 37-39, and is therefore incorporated herein by reference. As a result, each of claims 35 and 37-39 must be allowable over Atkins.

In view of the above, Applicants respectfully request the withdrawal of the §102(b) rejection of claims 35 and 37-39 and reconsideration thereof.

III. Claims 23, 31, and 36 Are Not Obvious Over Atkins and Hershfield

A. The Claims

1. Claim 23

In the August 26, 2004 Office Action, the Examiner rejected claim 23 as allegedly being obvious over Atkins and Hershfield. Applicants respectfully submit that claim 23 is not obvious over Atkins and Hershfield since 1) Atkins does not teach each and every limitation of the base claim of claim 23 (i.e. independent claim 21), and 2) Hershfield does teach the limitations lacking in Atkins.

As pointed out by the above arguments regarding the patentability of independent claim 21, of which arguments are specifically incorporated herein by reference, Atkins does

not anticipate independent claim 21 since Atkins does not teach a singular spark gap. Hershfield does not teach or suggest (and thus is not cited by the Examiner for so teaching or suggesting) a singular spark gap as recited in independent claim 21. Therefore, the combination of Atkins and Hershfield can not overcome the shortcomings of Atkins regardless of any additional teaching supplied by Hershfield. Moreover, claim 23, which depends from and thus incorporates the limitations of independent claim 21, is not obvious over Atkins and Hershfield. As a result, claim 23 is allowable over Atkins and Hershfield.

In view of the above, Applicants respectfully request the withdrawal of the §103(a) rejection of claim 23 and reconsideration thereof.

## 2. Claim 31

In the August 26, 2004 Office Action, the Examiner rejected claim 31 as allegedly being obvious over Atkins and Hershfield. Applicants respectfully submit that claim 31 is not obvious over Atkins and Hershfield since 1) Atkins does not teach each and every limitation of the base claim of claim 31 (i.e. independent claim 27), and 2) Hershfield does not teach the limitations lacking in Atkins.

As pointed out by the above arguments regarding the patentability of independent claim 27, of which arguments are specifically incorporated herein by reference, Atkins does not anticipate independent claim 27 since Atkins does not teach a singular spark gap. Hershfield does not teach or suggest (and thus is not cited by the Examiner for so teaching or suggesting) a singular spark gap as recited in independent claim 27. Therefore, the

combination of Atkins and Hershfield can not overcome the shortcomings of Atkins regardless of any additional teaching supplied by Hershfield. Moreover, claim 31, which depends from and thus incorporates the limitations of independent claim 27, is not obvious over Atkins and Hershfield. As a result, claim 31 is allowable over Atkins and Hershfield.

In view of the above, Applicants respectfully request the withdrawal of the §103(a) rejection of claim 31 and reconsideration thereof.

### 3. Claim 36

In the August 26, 2004 Office Action, the Examiner rejected claim 36 as allegedly being obvious over Atkins and Hershfield. Applicants respectfully submit that claim 36 is not obvious over Atkins and Hershfield since 1) Atkins does not teach each and every limitation of the base claim of claim 36 (i.e. independent claim 34), and 2) Hershfield does not teach the limitations lacking in Atkins.

As pointed out by the above arguments regarding the patentability of independent claim 34, of which arguments are specifically incorporated herein by reference, Atkins does not anticipate independent claim 34 since Atkins does not teach a singular spark gap. Hershfield does not teach or suggest (and thus is not cited by the Examiner for so teaching or suggesting) a singular spark gap as recited in independent claim 34. Therefore, the combination of Atkins and Hershfield can not overcome the shortcomings of Atkins regardless of any additional teaching supplied by Hershfield. Moreover, claim 36, which

depends from and thus incorporates the limitations of independent claim 34, is not obvious over Atkins and Hershfield. As a result, claim 36 is allowable over Atkins and Hershfield.

In view of the above, Applicants respectfully request the withdrawal of the §103(a) rejection of claim 36 and reconsideration thereof.

IV. Conclusion

It is respectfully submitted that all claims are in condition for allowance. Accordingly, Applicants respectfully request withdrawal of all rejections, reconsideration of all claims, and that a timely Notice of Allowance of all claims be issued in this case.

Respectfully Submitted,

11-24-04  
November 24, 2004



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